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EXAMINER	
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ART UNIT	**PAPER NUMBER**
1616	

NOTIFICATION DATE	DELIVERY MODE
06/24/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/538,924	TOURNILHAC ET AL.	
	Examiner	Art Unit	
	DANIELLE SULLIVAN	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 March 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11,18,26-35,43-55 and 57-70* is/are pending in the application.

4a) Of the above claim(s) *8,18 and 29-35* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,9-11,26-28,43-55 and 57-70* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *5/27/2009*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-11, 18, 26-35, 43-55 and 57-70 are pending. Claims 58-70 have been added in the amendment filed 3/27/2009. Claims 1-7 and 9-1126-35, 43-55 and 57 are presented for examination on the merits as they read upon the elected subject matter. Claims 18 and 29-35 are withdrawn from consideration as being drawn to non-elected subject matter.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 12, 15, 26-28, 47-50, 52, 54 and 57 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, 6, 13, 39-41, 47, 48, 50, 51, 54 and 55 of U.S. Patent No. 7,078,026 (herein '026) in view of Vatter et al. (US 6,475, 500).

‘026 disclose a composition comprising a structuring polymer of formula III and pigments. ‘026 do not teach the compound capable of reducing enthalpy, octyldodecanol. It is for this reason that Vatter et al. (US 6,475, 500) is joined.

Vatter et al. teaches the compound capable of reducing enthalpy, octyldodecanol, is preferred as a non-volatile oil for use in cosmetic compositions to adjust the solubility o the solvent (column 10, lines 48-52). The composition contains silicone polymers and pigments (column 2, lines 14-32). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to combine the teachings of ‘026 and Vatter et al. to utilize octyldodecanol. One would have been motivated to

utilize octyldodecanol in a cosmetic composition because Vatter et al. teaches that it improves solubility.

Claim 1, 12 and 15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-9 of U.S. Patent No. 6,916,464 (herein '464) in view of Vatter et al. (US 6,475, 500).

'464 teach a composition comprising a structuring polymer of formula III. The teachings of Vatter et al. are addressed above. '464 do not teach the compound capable of reducing enthalpy or pigments. It is for this reason that Vatter et al. (US 6,475, 500) is joined. Therefore, it would have been obvious to one of ordinary skill at the time of the invention to combine the teachings of '464 and Vatter et al. to utilize octyldodecanol. One would have been motivated to utilize octyldodecanol in a cosmetic composition because Vatter et al. teaches that it improves solubility.

Furthermore, it would have been obvious to one of ordinary skill at the time of the invention to combine the teachings of '464 and Vatter et al. to utilize pigments. One would have been motivated to utilize pigment in a cosmetic composition because Vatter et al. teaches that they are routinely included in compositions containing silicone gelling agents and octyldodecanol.

Claim 1, 48, 49, 52-54 and 57 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 and 21-23 of U.S. Patent No. 6,958,155 (herein '155) in view of Vatter et al. (US 6,475, 500).

‘155 teach a composition comprising a structuring polymer of formula III and may further comprise pigments. The teachings of Vatter et al. are addressed above. '155 do not teach the compound capable of reducing enthalpy. It is for this reason that Vatter et al. (US 6,475, 500) is joined. Therefore, it would have been obvious to one of ordinary skill at the time of the invention to combine the teachings of ‘155 and Vatter et al. to utilize octyldodecanol. One would have been motivated to utilize octyldodecanol in a cosmetic composition because Vatter et al. teaches that it improves solubility.

Claims 1, 53-55 and 57 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 and 31 of U.S. Patent No. 7,329,699 (herein '699) in view of Vatter et al. (US 6,475, 500).

‘699 teach a composition comprising a structuring polymer of formula III and may further comprise colorants. The teachings of Vatter et al. are addressed above. '699 do not teach the compound capable of reducing enthalpy. It is for this reason that Vatter et al. (US 6,475, 500) is joined. Therefore, it would have been obvious to one of ordinary skill at the time of the invention to combine the teachings of ‘599 and Vatter et al. to utilize octyldodecanol. One would have been motivated to utilize octyldodecanol in a cosmetic composition because Vatter et al. teaches that it improves solubility.

The following are provisional ODP rejections.

Claim 1, 3, 12, 15, 53-55 and 57 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1, 4, 5, 12, 18, 19, 22, 23, 26-28 and 33 of copending application11/342,748 (herein '748) in view of Vatter et al. (US 6,475, 500).

‘748 teach a composition comprising a structuring polymer of formula III and colorants. The teachings of Vatter et al. are addressed above. '748 do not teach the compound capable of reducing enthalpy. It is for this reason that Vatter et al. (US 6,475, 500) is joined. Therefore, it would have been obvious to one of ordinary skill at the time of the invention to combine the teachings of ‘748 and Vatter et al. to utilize octyldodecanol. One would have been motivated to utilize octyldodecanol in a cosmetic composition because Vatter et al. teaches that it improves solubility.

Claim 1, 2, 53-55 and 57 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1, 4, 7, 8, 15, 22, 25, 28, 29, 25, 28 and 50 of copending application11/009,088 (herein '088) in view of Vatter et al. (US 6,475, 500).

‘088 teach a composition comprising a structuring polymer of formula III and may further comprise colorants. The teachings of Vatter et al. are addressed above. '088 do not teach the compound capable of reducing enthalpy. It is for this reason that Vatter et al. (US 6,475, 500) is joined. Therefore, it would have been obvious to one of ordinary skill at the time of the invention to combine the teachings of ‘088 and Vatter et al. to utilize octyldodecanol. One would have been motivated to utilize octyldodecanol in a cosmetic composition because Vatter et al. teaches that it improves solubility.

Claim 1, 12, 15, 53-55 and 57 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-7, 10 and 13 of copending application11/254,919 (herein '919) in view of Vatter et al. (US 6,475, 500).

'919 teach a composition comprising a structuring polymer of formula III and may further comprise colorants. The teachings of Vatter et al. are addressed above. '919 do not teach the compound capable of reducing enthalpy. It is for this reason that Vatter et al. (US 6,475, 500) is joined. Therefore, it would have been obvious to one of ordinary skill at the time of the invention to combine the teachings of '919 and Vatter et al. to utilize octyldodecanol. One would have been motivated to utilize octyldodecanol in a cosmetic composition because Vatter et al. teaches that it improves solubility.

Claims 1, 12, 15, 26-28, 47-49, 51, 52, 54 and 57 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 5, 6, 16, 28, 29, 36, 38, 45 and 46-53 of copending application 10/320,601 (herein '601) in view of Vatter et al. (US 6,475, 500).

'601 teach a composition comprising a structuring polymer of formula III and colorants. The teachings of Vatter et al. are addressed above. '601 do not teach the compound capable of reducing enthalpy. It is for this reason that Vatter et al. (US 6,475, 500) is joined. Therefore, it would have been obvious to one of ordinary skill at the time of the invention to combine the teachings of '601 and Vatter et al. to utilize octyldodecanol. One would have been motivated to utilize octyldodecanol in a cosmetic composition because Vatter et al. teaches that it improves solubility.

Claims 1, 12, 15, 26, 27, 47-49, 51, 52, 54 and 57 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,

16, 56, 57, 58, 60-63, 66-75 and 79-85 of copending application 10/166,760 (herein '760) in view of Vatter et al. (US 6,475, 500).

'760 teach a composition comprising a structuring polymer of formula III and colorants. The teachings of Vatter et al. are addressed above. '760 do not teach the compound capable of reducing enthalpy. It is for this reason that Vatter et al. (US 6,475, 500) is joined. Therefore, it would have been obvious to one of ordinary skill at the time of the invention to combine the teachings of '760 and Vatter et al. to utilize octyldodecanol. One would have been motivated to utilize octyldodecanol in a cosmetic composition because Vatter et al. teaches that it improves solubility.

Claims 1-3, 12, 15, 26-28, 47-50, 52, 54 and 57 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 9-11, 16, 17, 20, 31-33 and 57-76 of copending application 10/166,755 (herein '755) in view of Vatter et al. (US 6,475, 500).

'755 teach a composition comprising t a structuring polymer of formula III and colorants. The teachings of Vatter et al. are addressed above. '755 do not teach the compound capable of reducing enthalpy. It is for this reason that Vatter et al. (US 6,475, 500) is joined. Therefore, it would have been obvious to one of ordinary skill at the time of the invention to combine the teachings of '755 and Vatter et al. to utilize octyldodecanol. One would have been motivated to utilize octyldodecanol in a cosmetic composition because Vatter et al. teaches that it improves solubility.

Claim 55 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 74 of copending application 10/733,467 (herein '467) in view of Vatter et al. (US 6,475, 500).

'467 teach a method of applying a composition comprising at least one coloring agent and a structuring polymer of formula III. The teachings of Vatter et al. are addressed above. '467 do not teach the compound capable of reducing enthalpy. It is for this reason that Vatter et al. (US 6,475, 500) is joined. Therefore, it would have been obvious to one of ordinary skill at the time of the invention to combine the teachings of '467 and Vatter et al. to utilize octyldodecanol. One would have been motivated to utilize octyldodecanol in a cosmetic composition because Vatter et al. teaches that it improves solubility.

Claim Rejections - 35 USC § 103

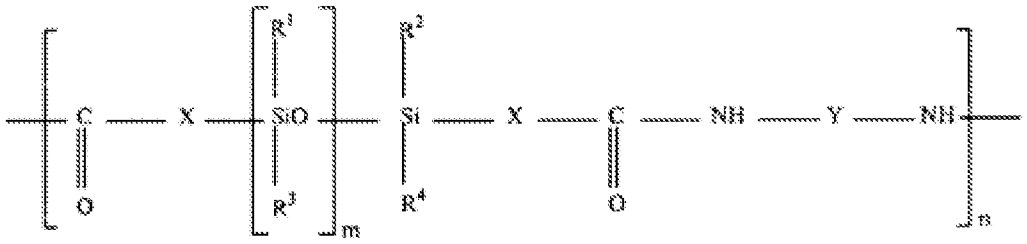
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-7 and 9-11, 26-28, 43-55 and 57-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calello et al. (US 6,033,650) in view of Petroff et al. (US 5,981,680).

Applicant's Invention

Applicant claims a composition comprising a) at least one pigment and b) a liquid continuous fatty phase comprising B1) at least one structuring polymer and B2) at least one compound capable of reducing the enthalpy of fusion of the structuring polymer, wherein the structuring polymer is formula III:



(III)

Claims 66, 67, 69 and 70 limit m to 10 to 100 or 15 to 500. Claim 68 specifies R1-R4 are methyl groups, X is an (oxy)alkylene group containing from 1 to 20 carbon atoms, and Y is an alkylene group containing 1-20 atoms. Claim 2 the fatty phase further comprises at least one hydrocarbon oil. Claim 3 the fatty phase further comprises at least one silicone oil. Claim 4 further comprises a volatile oil having a flash point ranging from 35 to 135 C. Claim 5 further comprises at least one volatile oil having a vapor pressure ranging from 0.01 to 300 mmHg, at 25C. Claims 6 and 7 further limit the volatile oil to isododecane. Claim 9 further comprises a nonvolatile silicone oil. Claim 10 specify the fatty phase contains at least 30% by weight of silicone oil. Claim 11 specifics the composition contains 3-89.4% of the volatile oil. Claims 26 and 27 specifies the polymer ranges from 0.5-80% and 5 to 40, respectively, of the composition. Claim 28 specifies the fatty phase comprises 5-99% of the composition.

Claims 43, 44 and 58 limit the compound capable of reducing the enthalpy of fusion to a linear or branched aliphatic monoalcohol having 8-26, preferably 12-26 carbon atoms, which is identified in claim 44 as octyldodecanol. Claim 45 specifies that the compound capable of reducing enthalpy ranges from 5 to 25 % of the composition. Claim 46 specifies the mass ratio of polymer to the compound capable of reducing enthalpy ranges from 0.1 to 50. Claim 47 further comprises a cosmetic or dermatological active agent. Claim 48 further specifies the active as being selected from an essential oil, a vitamin, a moisturizer, a sunscreen, a cicatrizing agent a ceramide, and mixtures thereof. Claim 49 further comprises and additive selected from a filler, an antioxidant, perfume or mixture thereof. Claim 50 specifies the pigment is selected from zinc, iron or titanium oxide. Claim 51 further comprises a dye(coloring agent). Claims 52 and 53 specifies the composition is a gel or stick (solid). Claims 54 and 57 specify different cosmetic forms of the composition which include a mascara, lipstick, etc. Claim 55 discloses a method of applying the composition to humans. Claims 59-65 limit the range of the compound capable of reducing enthalpy and the structuring polymer to 10 to 20% or 5-25% by weight of the composition.

Determination of the scope and the content of the prior art

(MPEP 2141.01)

Calello et al. teaches compositions for cosmetic use having improved transfer resistance. The compositions contain1-30% polymer, 1-40% volatile solvent, 0.5-30% nonvolatile oil, cyclomethicone and 0.1-80% dry particulate matter, which is largely titanium dioxide (pigments) (column 5, line 49 thru column 8, line 65). The volatile oils

include silicone oils and may be formulated as solid or gel (column2, lines 24-27, column 6, lines 27-39). The ranges vary due to whether the form is a lipstick, mascara, lotion, etc. Calello et al. discloses a composition comprising octyldodecanol 0.5%, titanium dioxide 0.1-9% and isododecane 9% (Example 2). Additional ingredients include humectants, thickeners and sunscreens (column 8, lines 24-27). Example 2 is a eyeshadow comprising 0.5% octyldodecanol with 7% cyclomethicone (silicone polymer).

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Calello et al. does not teach the silicon polyamide of formula III. It is for this reason that Petroff et al. is joined.

Petroff et al. teach the silicon polyamide of formula III. The compound is used in cosmetic compositions as thickening agents (column 2, lines 8-67). The compound is ideal for thickening dimethylcyclosiloxanes and is beneficial the a large number of personal care products (column 4, lines 4-10).

Finding of prima facie obviousness

Rationale and Motivation (MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Calello et al. and Petroff et al. to utilize the structuring polymer disclosed as formula III. One would have been motivated to include formula III because Petroff teaches that it is a thickening agent and is particularly

beneficial when used with dimethylcyclosiloxanes. Calello teaches a composition comprising cyclodimethicone (a dimethylcyclosiloxane) in Example 2 and also teaches the addition of thickening agents, therefore one would have been motivated to select this particular compound for use in thickening the composition disclosed in Example 2.

One would have been motivated to manipulate ranges during routine experimentation to discover the optimum or workable range since the Calello provides the general range of the ingredients. Therefore, one would have been motivated to use the appropriate amount of ingredients in order to make the different forms of the composition.

Response to Arguments

Applicant's arguments filed 5/27/2009 have been fully considered but they are not persuasive. Applicants argues that nothing in Callelo would have led one of ordinary skill in the art to combine octyldodecanol with the specified polymer. The Examiner strongly disagrees with this viewpoint. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Hence, it is the combination of Callelo and Petroff et al. that must be considered.

First, Callelo teaches an enhanced gloss which provides excellent adhesion to the skin, superior transfer resistance and high gloss comprising 0.1-60% of a polymer and 0.1-60% of a nonvolatile oil (column 1, lines 46-52; column 2, lines 1-12). Example

2 teaches an eye shadow comprising 0.5% octyldodecanol with 7% cyclomethicone (silicone polymer).

The polymers preferably comprise repeating siloxane moieties (column 2, line 30 through column 3, line 17). Furthermore, Callelo specifies the nonvolatile oil preferably has a viscosity ranging from 10-1,000,000 centipoise at room temperature (column 5, lines 49-55).

While Callelo lacks the specific formula (III), Petroff et al. provides motivation to combine the specific compound with a formulation of Callelo. Petroff et al. teach that formula (III) is a thickening dimethylcyclosiloxane that modifies viscosity in various cosmetics for the skin (column 1, lines 30-35). Hence, it would have been obvious to combine the teachings of Callelo and Petroff et al. and add formula (III) in order to modify the viscosity of the formulation. Furthermore, as evidenced by Vatter et al., octyldodecanol is preferred as a non-volatile oil for use in cosmetic compositions to adjust the solubility of the solvent (column 10, lines 48-52).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danielle Sullivan whose telephone number is (571) 270-3285. The examiner can normally be reached on 7:30 AM - 5:00 PM Mon-Thur EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Danielle Sullivan
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/Johann R. Richter/

Supervisory Patent Examiner, Art Unit 1616